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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,233

12/31/2003

Robert L. Martuza

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EXAMINER

SHEN, WU CHENG WINSTON

ART UNIT

PAPER NUMBER

1632

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/748,233	Applicant(s) MARTUZA ET AL.	
	Examiner Wu-Cheng Winston Shen	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner prosecuting this case has changed. All inquiries directed to the application should be directed to examiner W. - C. Winston Shen.

Applicant's response received on 12/22/06 has been entered. Claims 1-6 are cancelled. Claims 7-18 are pending.

This application filed on December 31, 2003 is a divisional of Ser. No. 09/625,509, filed July 25, 2000, now U.S. Pat. No. 6,699,468, which is a divisional of Ser. No. 09/004,511, filed Jan. 8, 1998, which is a continuation-in-part of U.S. patent application Ser. No. 08/478,800, filed Jun. 7, 1995, now abandoned, which is a divisional of U.S. Ser. No. 08/264,581 filed Jun. 23, 1994, now U.S. Pat. No. 5,585,096.

The series of parent applications of instant application listed above is based on the amendments of Specification filed on 9/8/2004.

Status of claims: Claims 7-18 are currently under examination.

Priority

1. In the response to Non-Final rejection mailed on 10/4/2006, Applicant pointed out that the Examiner omitted priority claim to U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096), filed June 23, 1994. The Examiner acknowledges that the information regarding omitted priority to U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096) was

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indeed submitted by applicants as amendments of Specification filed on 9/8/2004. It is noted that the specification of U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096), filed June 23, 1994 supports the claims of instant application (See forth paragraph, column 4, U.S. Patent No. 5,585,096). Therefore, the priority of claims of instant application is determined to be 06/23/1994.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Previous rejection of claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because claim 10 recites that the HSV is "G207", is ***withdrawn*** because applicants provided exemplary references in the research filed of HSV (Herpes Simplex Virus) indicating that G207 is a well established HSV viral construct, which refers to an oncolytic HSV with deletions at both $\gamma(1)$ 34.5 loci and a LacZ gene insertion inactivating the HSV ribonucleotide reductase.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Previous rejection of claims 7-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Martuza et al. (US Patent 5,85,096 Dec 1996) is *withdrawn* because the priority date is instant application is determined to be 06/23/1994, which is the filing date of Martuza et al. (US Patent 5,85,096 Dec 1996).

Previous rejection of claims 7-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Martuza et al. of WO 96/00007 (1/1996) is *withdrawn* because the priority date is instant application is determined to be 06/23/1994, which is the filing date of Martuza et al. (US Patent 5,85,096 Dec 1996).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Previous provisional rejection of claims 7-18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-29 of copending Application No. 10/788,410, is ***maintained*** for the reasons of the record. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to the same herpes virus construct. In each case the claims as a whole set forth a herpes virus comprising an alteration in γ 34.5, a heterologous gene of interest and an alteration in the ribonucleotide reductase gene.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 7-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 35-39, 43-46 of copending Application No. 11/097,391, is ***maintained*** for the reasons of the record. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to the same herpes virus construct. In each case the claims as a whole set forth a herpes virus comprising an alteration in 3,34.5, a heterologous gene of interest and an alteration in the ribonucleotide reductase gene. For example claim 10 and claim 39 both set forth that the HSV is G207.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. No claim is allowed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be directed to Wu-Cheng Winston Shen whose telephone number is (571) 272-3157 and Fax number is 571-273-3157. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the supervisory patent examiner, Peter Paras, can be reached on (571) 272-4517. The fax number for TC 1600 is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PETER PARAS, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



Wu-Cheng Winston Shen, Ph. D.

Patent Examiner

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